PHA 2176 (3564) PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of D. Brown et al. Art Unit 1625
Serial No. 09/839,424
Filed April 20, 2001
Confirmation No. 1761
For 2-FLUOROBENZENESULFONYL COMPOUNDS FOR THE TREATMENT OF INFLAMMATION
Examiner: B. Robinson

August 28, 2002

RESPONSE TO RESTRICTION REQUIREMENT

TO THE ASSISTANT COMMISSIONER FOR PATENTS,

SIR:

This letter is in response to the Office action mailed on July 30, 2002, in which an election of a Group of claims and an election of a single disclosed species for prosecution on the merits was requested.

According to 35 U.S.C. §121, a restriction is proper only if there are at least two independent and distinct inventions. Furthermore, "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions."[1] No showing has been made by the Office that the search and examination of this entire application will require serious burden. Instead, the Office merely asserts that "the different inventions have achieved a separate status in the art, have separate fields that aren't

[1]MPEP §803 (emphasis added).

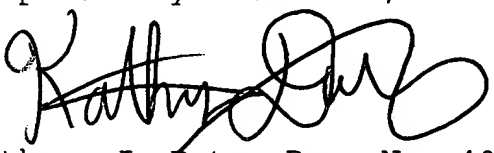
coextensive, and are capable of supporting separate patents."[2] Restriction is not proper in this case.

Subject to the foregoing traverse, applicants elect Group I, claims 1-8, 11-16, 31, 32, 35-38, 40, 41, 92, 94, 99, 101, and 105-113. Moreover, applicants hereby elect the species recited on page 157, the compound of Example 1. Claims 1-3, 5-7, 11-16, 31-32, 35-41, 92, 99, 101, and 106-113 read on the elected species.

According to M.P.E.P. §809.02(c), an examiner's action subsequent to an election of species should include a complete action on the merits of all claims readable on the elected species and according to M.P.E.P. §809.02(e), whenever a generic claim is found to be allowable in substance, action on the species claims shall thereupon be given as if the generic claim were allowed. Thus, if it is determined that the elected species is patentable, it is incumbent upon the Office to search additional species that fall within any allowable generic claims.

Applicants reserve the right to file divisional applications directed to the non-elected subject matter.

Respectfully submitted,



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[2]Paper 8 at page 4.